

## REMARKS

### Summary of the Claims

With the present Office Action, claims 1-4, 6-12, 14-20, 22-28, and 30-33 were pending in the application. Claims 1-4, 6-12, 14-20, 22-28, and 30-33 were rejected under 35 U.S.C. § 103. With the present Amendment, claims 29-33 have been cancelled. After entry of the above Amendment, claims 1-4, 6-12, 14-20, and 22-28 will be pending in the application.

### Amendments to the Claims

The Applicants have amended the pending claims to further clarify what is regarded as the claimed invention. It is respectfully submitted that the amendments introduce no new matter, and are supported by the application as filed. It is respectfully submitted that the amended claims are patentable over all art cited against the application.

### Rejections Under 35 U.S.C. § 103

Claims 1-4, 6-12, 14-20, and 22-28 have been rejected under 35 U.S.C. § 103 over U.S. Pat. No. 5,963,864 to *O'Neil et al.* ("*O'Neil*") in view of U.S. Pat. No. 6,694,004 to *Knoerle* ("*Knoerle*"). The Applicant traverses all of the rejections under 35 U.S.C. § 103.

While there are numerous distinctions between the pending claims and the cited art, the Applicants again note that none of the cited references teach or otherwise disclose the claimed "appended wireless call indication digit," a feature recited in each of the independent claims. In the Office Action<sup>1</sup>, the wireless call indication "digit" is construed by the Office as a "flag." The Office points the Applicants to various portions of *O'Neil*, which the Applicants have carefully considered in their entirety. As will be explained, the Applicants maintain that at

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<sup>1</sup> The Office Action mailed on September 30, 2008, page 5.

least this explicitly claimed feature is simply not taught by the cited art. For at least this reason, all of the claims are patentable over the cited art, as will be explained in more detail below.

*O'Neil* is cited<sup>2</sup> in the Office Action<sup>3</sup> as teaching the claimed “wireless indication digit.” However, *O'Neil* *clearly* cannot be construed as teaching a “wireless indication digit appended to a telephone number...,” as claimed by the Applicants. Instead, *O'Neil* explicitly describes how “the services node 30 is programmed in a conventional manner...[such that the SN] 30 receives the communication from the end office 16b, [and]...uses the *number that was dialed by the caller*...”<sup>4</sup> *O'Neil* continues by apparently describing how the dialed number can be used to perform a database lookup to determine “the wireless number that is to serve as the extension to the wireless number.”<sup>5</sup>

The Applicants refrain at this time from characterizing the dialed number used and disclosed by *O'Neil*. Nonetheless, the Applicants respectfully submit that using the “number that was dialed by the caller,”<sup>6</sup> regardless of how that number is characterized, cannot fairly be construed as a “wireless indication digit *appended* to a telephone number,”<sup>7</sup> as claimed by the Applicants in the amended claims.<sup>8</sup>

Furthermore, as noted in the specification, the wireless indication digit can be included, even in cases in which the “SN 34 does have data regarding the subscriber’s wireless directory number.”<sup>9</sup> In other words, the wireless indication digit can supplement the wireless directory number. As such, the Applicants respectfully submit that construing “a wireless indication digit, appended to a telephone number” as a “number dialed by a caller” is improper. The Applicants

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<sup>2</sup> Column 20, lines 31-47.

<sup>3</sup> Page 5.

<sup>4</sup> Column 20, lines 31-47 (emphasis added).

<sup>5</sup> *Ibid.*

<sup>6</sup> *Ibid.*

<sup>7</sup> Claims 1, 10, 18, and 26.

<sup>8</sup> Please note that the “appended to” language was recited before the present Amendment.

<sup>9</sup> Page 17 of the Application.

further note that nothing in *Knoerle* can cure the deficiencies of *O'Neil* noted above.

For at least these reasons, claims 1, 10, 18, and 26, as well as all claims depending therefrom, are patentable over all art cited against the application.

As such, the Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

### **U.S. Patent No. 6,694,004 is not Prior Art**

Claims 1-4, 6-12, 14-20, and 22-28 have been rejected under 35 U.S.C. § 103 over U.S. Pat. No. 5,963,864 to *O'Neil et al.* (*O'Neil*) in view of U.S. Pat. No. 6,694,004 to *Knoerle* (*Knoerle*). The Applicants traverse all of the rejections under 35 U.S.C. § 103.

While there are numerous distinctions between the pending claims and the cited art, the Applicants respectfully submit that *Knoerle* is not an effective prior art reference under the provisions of 35 U.S.C. § 103(c), as explained below. The Office has claimed, during prosecution, that *Knoerle* can be “considered” a 102(b) reference because of an alleged admission in the background section of *Knoerle*. This position does not have support in the Patent Act, the rules, and/or the common law, as will be clarified below. Since *Knoerle* is not an effective prior art reference, *Knoerle* cannot be used in a rejection as proposed by the Office.

*Knoerle* was filed on December 28, 2000, less than one year before the filing date of the present application. The Application from which *Knoerle* issued was never published under the provisions of 35 U.S.C. § 122(b), and did not issue until February 17, 2004. As such, *Knoerle* is not an effective prior art reference against the present Application under 35 U.S.C. § 102(a) or (b).

The Office previously claimed<sup>10</sup> that the background section of *Knoerle* can be “considered” prior art under 102(b) because the alleged admission

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<sup>10</sup> Page 25 of the Office Action mailed on July 18, 2007.

appears in the background section of the applied reference. In an attempt to support this position, the Office cites the M.P.E.P. at sections 2129.I and 2129.II. Regardless of where a disclosure occurs in a patent application, the matter does not become prior art under 35 U.S.C. § 102(b) unless all of the requirements under that section are satisfied, *e.g.*, “more than one year,” and the like, which do not appear to be met in this case. The court in *Riverwood*<sup>11</sup> was dealing with matter recited in the background of the applicant’s specification, not a background section of a cited document.

If Congress intended for 35 U.S.C. § 102(b) to include an exception such as that proposed by the Office, the exception would be recited in the statute. However, no such exception is recited. Furthermore, the one year limitation, which is clearly recited in the statute is not met here. Certainly, the application from which *Knoerle* issued was not filed more than one year before the filing date of this application. Whether or not the Assignees are the same, the text and requirements of 35 U.S.C. § 102(b) are static.

As such, the *Knoerle* reference may only be prior art under 35 U.S.C. § 102(e). 35 U.S.C. § 103(c)(1) states:

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

As of June 8, 2001, the filing date of the present Application, *Knoerle* was assigned to “BELLSOUTH INTELLECTUAL PROPERTY CORPORATION,” via an assignment executed on March 19, 2001, and recorded in the Official Patent Office Records on April 5, 2001 at reel 011674 at frame 0084.

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<sup>11</sup> *Riverwood Int’l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354 (Fed. Cir. 2003).

The present Application was assigned to "BELLSOUTH INTELLECTUAL PROPERTY CORPORATION," via an assignment executed on May 8, 2001, and recorded in the Official Patent Office Records on June 8, 2001 at reel 011891 at frame 0168.

These assignments are evidence, in the Official Patent Office Records, that the Applicants were under an obligation to assign the present application to the assignee of *Knoerle* at the time the claimed invention was made.

Since *Knoerle* is not prior art for purposes of this application, the rejections over *Knoerle* should be withdrawn. Since the Office concedes<sup>12</sup> that *O'Neil* does not teach each and every element of the Applicants' claims, the rejections should be withdrawn.

For at least these reasons, claims 1, 10, 18, and 26, as well as all claims depending therefrom, are patentable over all art cited against the application.

As such, the Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103 for an additional reason.

#### **Fees**

No fees are believed due with the filing of this communication. The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 50-3447.

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<sup>12</sup> Office Action at page 5.

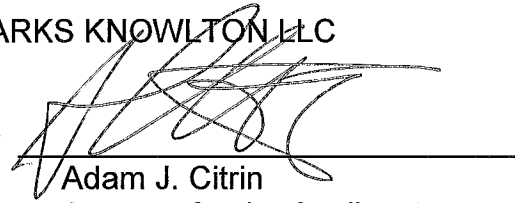
**Conclusion**

It is respectfully submitted that the application is in condition for allowance, and notice to that effect is respectfully requested. If Examiner Daniel has any new concerns, he is respectfully urged to contact the undersigned representative at his earliest convenience.

Respectfully Submitted,

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